Question Q217

National Group: China

Title: **The patentability criterion of inventive step / non-obviousness**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

   Article 22, paragraph three, of the Chinese Patent Law provides the definition and standard of inventiveness. According to the Law, inventiveness means that, as compared with the prior art, the invention has prominent substantive features and represents a notable progress.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

   The standard has not changed in the last 20 years. It should be noted that the absolute novelty criteria is introduced in the third amendments to the Chinese Patent Law, which broadens the scope of prior art.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

   Yes, the State Intellectual Property Office (SIPO) of China publishes examination guidelines on inventive step/non-obviousness. As China is not a case law country, these guidelines interpreting the patent law and the implementing regulations are actually the only resources used

by the SIPO examiners and the judges in the courts when dealing with inventive step/non-obviousness issues. Therefore, they are very useful and effective during examination, invalidation proceedings and litigation.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

   No, the standard for inventive step / non-obviousness does not differ during examination versus during patent administrative litigation or invalidity proceedings. In infringement litigation, the courts do not assess the validity of the patent.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

   The claims should be construed according to the wordings of the claims in consideration of the understanding of a person skilled in the art to the claims through reading the specification and the drawings.

6. Is it possible to read embodiments from the body of the specification into the claims?

   It is not allowed to read embodiments from the body of the specification into the claims during examination.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

   The prior art should be interpreted as would be understood by a person skilled in the art, and the inherent disclosures that can be derived directly and unambiguously from the prior art is permitted. The Guidelines for Patent Examination of the SIPO provides that the technical contents disclosed in the prior art include not only those technical contents literally described in the prior art but also those implied technical contents that can be derived directly and unambiguously from the disclosure by a person skilled in the art.

8. Do the answers to any of the questions above differ during examination versus during litigation?

   The answer to question 6 is different during examination versus during infringement litigation. During the infringement litigation, where a technical feature in claims is expressed in way of functions or effects, the court will determine the content of the technical feature in consideration of the detailed embodiments of the functions or effects described in the specification and drawings and equivalents thereof, that is, it is possible to read embodiments from the body of the specification into the claims for functional features during infringement litigation.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

   Yes, it is proper in our jurisdiction to find lack of inventive step or obviousness over a single prior art reference. The missing teachings can be provided by the same prior art reference or common general knowledge. In this case, argument may be sufficient.

   The level of common general knowledge is an issue to be considered to find inventiveness. The common general knowledge refers to a customary means in the art or a technical means disclosed in a textbook or reference book.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

    Teaching or motivation to combine two or more prior art references is required. The teaching or motivation to combine may be explicit or implicit.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

    When two or more prior art references are combined, the closest prior art shall preferably be from the same or similar technical field as what is being claimed. The other prior art references are not necessarily in the same or similar technical field.

    When two or more prior art references are combined, the problem that is actually solved by the claim in question is to be considered, not the problem the inventor of the claim in question was trying to solve.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

    Yes, it is permitted in our jurisdiction to combine more than two references to show lack of inventive step or obviousness.

    The standard is not different from when only two references are combined.

13. Do the answers to any of the questions above differ during examination versus during litigation?

    No, the answers to any of the questions above do not differ during examination versus during patent administrative litigation.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

First, the technical problem is a factor to be considered in determining the closest prior art.

Second, the technical problem actually solved by the invention, which is determined through the identification of distinguishing features between the invention and the closest prior art, is a key factor to be considered in the evaluation of prominent substantive feature of the claimed invention.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem must be described clearly and objectively in the specification to meet the following requirements:
(i) directing against the defect or deficiency existing in the prior art;
(ii) describing objectively, in positive and concise words and with good grounds, and
(iii) no commercial advertising used to describe the technical problem to be solved.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

The role of advantageous effects is a primary factor in evaluating the notable progress represented by the invention.

17. Must the advantageous effects be disclosed in the as-filed specification?

The advantageous effects of the invention as compared with the prior art must be clearly and objectively described in the as-filed specification.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes, but the later-submitted data must be comparative test data. The comparative test data shall be directed to a technical effect that has been explicitly disclosed and for which test data have been provided in the as-filed specification.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

Advantageous effects mean the effects which directly result from the technical features constituting the invention, or the effects which these technical features are bound to produce.

The advantageous effects may be described by way of analysis of the structural features of the invention in combination with theoretical explanation, or illustrated with reference to experimental data. However, for an invention in the field of chemistry or biology, experimental data is generally required to demonstrate the advantageous effects, and paper or hypothetical examples are not allowed for this purpose.

20. Do the answers to any of the questions above differ during examination versus during litigation?

No, the answers to any of the questions above do not differ during examination versus during patent administrative litigation.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

No, teaching away is not recognized as a factor in favor of inventive step in the Law, Regulations or Guidelines for Patent Examination.

In Chinese patent practice, among the factors to be considered when evaluating the inventive step, there is a factor, technical prejudice, which is similar to teaching away, but not exactly the same. Technical prejudice refers to the understanding that is popular in a certain field during a certain time period and departs from the objective fact, which leads those skilled in the art to believe that there is no other possibility.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away is not recognized as a factor in favor of inventive step in the Law, Regulations or Guidelines for Patent Examination.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the claimed invention and the secondary considerations required?

Acceptable secondary considerations include:
(1) solving a long-felt but unsolved technical problem;
(2) overcoming technical prejudice;
(3) producing unexpected technical effect; and
(4) achieving commercial success.

These factors must be proved by sufficient evidence.

A close connection between the claimed invention and the secondary considerations is required. For example, if the claimed invention achieves commercial success, and if such success is directly brought about by the technical features of the invention, it can be used as a basis for assessing inventive step. However, if the success is brought about by other factors, such as an advance in selling techniques or advertising, it shall not be used as a basis for assessing inventive step.

26. Do the answers to any of the questions above differ during examination versus during litigation?

No, the answers to any of the questions above do not differ during examination versus during patent administrative litigation.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

If yes, please describe these issues, tests, or factors.

Basically, there are no other issues or factors. However, the Chinese Patent Examination Guidelines provide further detailed guidance on the evaluation of the inventive step of different types of inventions such as breakthrough inventions, selection inventions, combination inventions, etc.. The factors discussed in questions 4-26 above will be weighed differently depending on the types and natures of the inventions.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

Inventive step/non-obviousness of an invention means, as compared with the prior art, the invention has prominent substantive features and represents notable progress".

(A) According to the Guidelines for Patent Examination, to determine whether an invention has prominent substantive features is to determine whether the claimed invention is non-obvious to the person skilled in the art as compared with the prior art. Usually the following

three steps are followed to determine whether a claimed invention is non-obvious as compared with the prior art
(1) Determining the closest prior art
(2) Determining the distinguishing features of the invention and the technical problem actually solved by the invention
(3) Determining whether or not the claimed invention is obvious to a person skilled in the art.

To be specific, an invention does not have prominent substantive features if there exists a technical motivation in the prior art as to apply the distinguishing features of the invention to the closest prior art in solving the technical problem actually solved by the invention.

(B) According to the Guidelines for Patent Examination, when evaluating whether an invention represents notable progress, the primary factor to be considered is whether or not the invention produces advantageous technical effects.

There is no other jurisprudence or authoritative literature further interpreting the meaning of such test.

29. Does such test differ during examination versus during litigation?

No, such test does not differ during examination versus during patent administrative litigation.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

In China, the same approach is used to determine inventive step / non-obviousness during examination and litigation.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

No.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

In China, there is only one patent granting authority, i.e. the SIPO.

33. If yes, is this problematic?

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Harmonization may be desirable for the convenience of the applicants and reduction of repetitive workload of the patent offices.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

It is difficult to find a universally-accepted standard for inventive step/ non-obviousness due to different legal systems in different countries.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

Inventive step /non-obviousness means that, compared with the existing technologies, the invention possesses prominent substantive features. The existing technologies mean the technologies known to the public both domestically and abroad before the date of application.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

The approach for determining whether a claimed invention is obvious is proposed as below:
Step 1: determining the closest prior art;
Step 2: determining the distinguishing features of the invention and the technical problem actually solved by the invention;
Step: 3: determining whether or not the claimed invention is obvious to a person skilled in the art.

SUMMARY

According to Chinese Patent Law, inventive step means that, as compared with the prior art, the invention has prominent substantive features and represents notable progress. As China is not a case law country, the examination guidelines of the SIPO are actually the only resources for determining the inventive step during examination, invalidation and litigation. The test for inventive step includes the steps of: (1) identifying the closest prior art; (2) establishing the distinguishing features of the invention and the technical problem actually solved by the invention; and (3) determining whether or not the claimed invention is obvious to a person skilled in the art. In addition, advantageous effects and secondary considerations such as solving a long-felt but unsolved technical problem, overcoming technical prejudice and producing unexpected technical effects are also considered when establishing inventive step. Basically, the practice for inventive step does not differ between the SIPO and the courts.